

a2  
cont.  
continuously urge said tread base from said first position to said second position, said gas cylinder exerting a rotational torque less than the rotational torque of the gravitational force acting on the tread base in said first position.

### REMARKS

Upon entry of the amendments, claims 1 through 13 will be in the case.

#### Specification

Applicants here seek to make a correction to the specification to correct the syntax or grammar of a sentence. No new matter is presented.

#### Provisional Double Patenting

Claims 1 through 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of one copending application, namely: serial number 08/593,801 (hereinafter the "'801 Application"). The provisional rejection is predicated on physical differences between claimed inventions that are asserted to not be patentably distinct because claim 1 reads on claim 1 of the '801 Application. More specifically, it is asserted that the support structure in claim 1 of the present application reads on the freestanding housing of claim 1 of the '801 Application.

#### 1. Policy Behind Rejection Does Not Apply

The provisional rejections are based on the judicially created doctrine of double patenting. Applicants now assert that the basis for obviousness-type double patenting under the judicially created doctrine is no longer extant. As stated in In re Longi, 225 U.S.P.Q. 645, 648 (Fed. Cir. 1985), "(a) double patenting rejection precludes one person from obtaining more than one valid patent for either (a) the 'same invention' or (b) an 'obvious' modification of the same invention." A "same invention" rejection is based on 35 U.S.C. § 101 and refers to IDENTICAL SUBJECT MATTER. The "obviousness" type rejection is based on public policy as reflected in the patent statutes "to prevent the extension of the term of a patent." In re Longi, *supra*.

The objective of the policy of the judicial doctrine is to ensure that the public is free to use an invention and obvious modifications or variants upon expiration of the first patent. In re Zickendraht, 319 F.2d 225, 232, 138 U.S.P.Q. 23, 27 (C.C.P.A. 1963). Indeed, the

only real objection to double patenting is the unwarranted extension of the patent monopoly. In re Van Ornum and Stang, 214 U.S.P.Q. 761, 769 (C.C.P.A., 1982) citing In re Siu, 222 F.2d 267, 105 U.S.P.Q. 428 (C.C.P.A., 1955). The focus of the obviousness-type double patenting rejection is the prevention of an extension of the patent right beyond the statutory limits. In re Goodman, 29 U.S.P.Q. 2011, 2015 (Fed.Cir. 1993); c.f., In re Braithwaite, 154 U.S.P.Q. 29, 34 (C.C.P.A. 1967); In re Sutherland, 146 U.S.P.Q. 485, 491 (C.C.P.A. 1965); in accord, MPEP § 804, Part II. B. (at page 800-17).

Under the recently enacted changes to title 35 of the U.S. Code, the term of any patent to issue from the present application and any of the other applications cited as part of the rejection WILL BE IDENTICAL. 35 U.S.C. § 154(a)(2) specifies that "such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States." (Emphasis added). In this case the application cited was filed on the same day this application was filed. Thus, any patents that issue will not have different expiration dates. Absent different expiration dates, there is no way for Applicants to extend the term. The inability to extend the patent term because it is now controlled by the filing date rather than the issue date was recognized by the PTO in comments relating to certain new rule changes required because of the changes to the patent statutes regulating the term of patents. See the OFFICIAL GAZETTE, May 2, 1995 at page 1174 OG 18, col. 2, 8-11 lines from the bottom. That is, in this case, all the applications have exactly the same filing date and, in turn, all issuing patents must have the same expiration date should more than one patent issue.

In the case of Electric Storage Battery Co. v. Shimadzu, 307 U.S. 5, 59 S. Ct. 675, 41 U.S.P.Q. 155 (1939), Shimadzu was the owner of two U.S. patents. The defendant in an infringement suit raised a number of defenses one of which was invalidity due to double patenting. The Supreme Court appears to have favorably quoted the trial court which had held that no double patenting was involved because the two patents central to the question had issued on the same day. In turn, it was clear that no extension of the patent monopoly was involved. (See last page of opinion). The same issue is present here. There is no possible extension of the patent monopoly; so double patenting cannot be a proper basis for

A

the rejection. Thus, the rejection is flatly opposite to the controlling authority of the Supreme Court.

MPEP § 804 is consistent with the case law authorities and states that the policy behind obviousness-type double patenting is an unwarranted extension of the patent term. Since that cannot happen, the entire premise for provisional obviousness-type double patenting is no longer extant. In turn, the entire rejection is without factual or legal support. The rejection should be withdrawn.

2. Combination Claims Cannot be Rejected Over One Element

In the case of In re Schneller, 158 U.S.P.Q. 210, 215-6 (C.C.P.A. 1968), at issue was a potential double patenting between combination claims involving the same elements but for one. The court held that a "combination claim does not cover or read on a single element." By analogy the court further reasoned that a combination claim for invention ABCX is different from ABCY and variations thereof. 158 U.S.P.Q at 216. In other words, a claim must be taken as a whole and evaluated without considering the specification of the other application as prior art because it is not prior art.

In this case, it appears that the double patenting rejection is premised not on the claims as a whole but rather on the basis that it is only the freestanding housing feature in the other cited applications that is to be considered. However, it is error, for example, to focus only on the freestanding housing of the '801 Application because the '801 Application sets forth a novel combination and not just one element. The issue then is whether there is double patenting if invention ABCX is in one case and invention ABCY is in another. Under Schneller, there is no double patenting when considering the whole claim absent prior art that suggests the whole claimed structure.

In the case at hand, in view of identical filing dates and identical issue dates (should patents issue), the inventions will be combinations of elements each of which combinations are separately patentable. Therefore, it is not proper to focus on one element and assert that obviousness precludes patenting under the double patenting doctrine. Rather, the claims must be evaluated as a whole.

3. The Test Not Met

MPEP § 804, Part II. B. 1., sets out a four-point test to determine if double patenting may be asserted.

(1) The first element is to determine the scope and content of the patent claim at issue and the prior art relative to the claim of the application at issue.

In the context of this application, the inquiry would necessitate an evaluation of only the prior art because the other application cannot be prior art no matter if and no matter when a patent issues on the other application, if ever. Thus, the combination claim of the '801 Application must be examined in its entirety in view of prior art. However, the asserted provisional rejections do not establish obviousness based on prior art. Therefore, the first element of the test has not been shown to be satisfied.

(2) The second element is to determine the differences between the scope and content of the patent claim and prior art.

In this case, there is no prior patent and there never can be a prior patent. Thus, all the analysis of so called obviousness must be predicated on prior art excluding the specifications of the cited application. There is no evidence in the record that such an analysis was ever undertaken. Indeed, it is asserted that to the extent this analysis is to be attempted, it must only rely on prior art such as Day, Doetsch and Dalebout. Claim 1 as now amended clearly is not taught or suggested by those references.

(3) The third element requires a determination of the level of ordinary skill in the art. There is no affirmative statements that identify what is the level of ordinary skill.

Certainly, patents reflect extraordinary skill and not ordinary skill. Thus, reference to prior patented combinations such as Dalebout or Dalebout '776 does not reveal even indirectly what the ordinary level of skill is or is asserted to be. If there is to be a basis to assert that certain combination claims, which are in effect ABCX (see In re Schneller, supra) are obvious advancements over ABCY, one must focus on the ordinary and not extraordinary skill and establish by some factually supported premise what the skill level is of that theoretical person. The record does not show any evidence to this effect.

(4) The fourth element requires evaluation of any objective indicia of copying. In this case, none has been offered. That is, Applicant has not offered evidence of commercial success or the like.

MPEP § 804 also requires a clear presentation of the differences and the reasons why one of ordinary skill would conclude that the combinations are obvious variations. Applicants assert that the offered explanations do not provide a clear presentation on their face and because they focus on one element and not on the claimed structure as a whole.

Given these deficiencies, the four-point test cannot be deemed satisfied in reference to each and all of the cited applications. Assuming the brief statement in the record is presented to meet the test, Applicants assert that the test has not been shown to be satisfied.

It is asserted that the support structure of claim 1 as now amended reads on the freestanding housing of claim 1 of the '801 Application. Claim 1 of the '801 Application specifies that certain enclosure structure be extant. Thus, claim 1 of the present application differs from claim 1 of the '801 Application in a very specific way. This difference may lead to one claim dominating over the other, but they clearly are not coextensive or obvious variations. To support the rejection it must be asserted and shown that the enclosure structure of claim 1 of the '801 Application is an obvious variation of the structure of claim 1 as amended by the present application. There has been no showing of art that would make such structure obvious or an obvious variation of the structure defined by claim 1 to one of ordinary skill in the art. In turn, the rejection is without foundation and it should be withdrawn.

#### Non-Provisional Double Patenting

Claims 1-9 are also rejected (not provisionally) under the doctrine of double patenting (not obviousness-type) over the claims of serial number 08/593,793 (hereinafter the "'793 Application"), the 08/593,795 Application (hereinafter the "'795 Application"), serial number 08/593,796 (hereinafter the "'796 Application"), serial number 593,798 (hereinafter the "'798 Application") and serial number 08/584,271 (hereinafter the "'271 Application"). The rejection is based on the assertion that all the applications are claiming common subject matter, namely a treadmill having support structure, a base with left and right sides, and an

endless belt. The common treadmill is configured to be operable between a first operation position and a second storage position.

In order to maintain a rejection for double patenting, the subject matter of the claim in one patent must be exactly the same as the subject matter in another. In re Longi, supra. That is, the claims must define the exact same subject matter. Id. In this case the rejection is totally lacking in factual support because it is uncontrovertible that the claims of the cases are significantly different.

a. '793 Application. The claims of the '793 Application all include "latching means" structure. None of the claims of the present application have claims that specifically recite "latching means." Accordingly, the rejection is without foundation.

From another perspective, it is clear that one could easily construct devices that infringe the claims of this application but not the '793 Application. In turn, the infringement analysis suggested by MPEP § 804, Part II. A., reveals the absence of a basis for statutory double patenting. That is, the claims flatly are different. The rejection should therefore be withdrawn.

b. '795 Application. The '795 Application defines a treadmill that includes a cover on its underside. None of the claims of the present application recite similar or comparable structure. In turn, it is clear that structures that would infringe claims of the '795 Application would not necessarily infringe claims of the present application and vice versa. In turn, the rejection is unsound and should be withdrawn.

c. '796 Application. Here again the inquiry must be whether the claims of the '796 Application are directed to the same subject matter as the claims in this case. None of the claims of the '796 Application have any language directed to the roller means and handle means addressed in the combination claims of this application. In short, the scope of the claims in the two cases is different. Structures that would infringe the claims of the present application would not necessarily infringe any of the claims of the '796 Application and vice versa. Thus, the claims are, by definition, different and not directed to the same subject matter. The rejection based on the '796 Application is therefore unsound and should be withdrawn.

d. '798 Application. The '798 Application has all claims directed to machines that include "inclination structure." All the claims in the present application do not contain such structure. Thus, it is possible for a machine to infringe the claims of the '798 Application without infringing any of the claims of this application. Therefore, the claims are directed to different subject matter. The rejection under the '798 Application is therefore without foundation and should be withdrawn.

e. '271 Application. The '271 Application has claims directed to a treadmill that can be tipped and rolled about much like a dolly or hand truck from a treadmill that has a tread base movable between a first position and a second position. No claims of the present application define similar structure. In turn, it can be seen that a machine may infringe claims of the present application and not claims of the '271 Application. In turn, it is clear that the claims are drawn to a different structure. The rejection, to the extent it is based on the '271 Application, is therefore without foundation and should be withdrawn.

f. No Common Subject Matter. In the Office Action at page 6, it is stated that the subject matter claimed in this application is fully disclosed in the referenced copending applications and "would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter . . . ." The common subject matter is asserted to be a "treadmill having a support structure, a tread base having right and left sides and an endless belt" in which the tread base is capable of movement between a first position and a second position.

From the above discussion, it can be seen that the cited applications and the present application do NOT CLAIM common subject matter. The disclosure is not of significance in this analysis. While the disclosure may be useful in construing the claims, the focus of all the cited case authorities dealing with the double patenting doctrine is on the claims. Since different machines can be structured that will infringe claims pending in this application and not any of the claims of any of the cited pending applications, the assertion of common subject matter is simply not supportable. Indeed, it is quite evident that a machine that infringes a claim in one of the applications would not necessarily infringe the claims of any other. Absent common subject matter and indeed absent identical subject matter, the rejection is unsound.

Further, all of the claims advanced are combination claims. It is improper to focus on one element of a combination claim and assert that it forms the basis for a rejection. The claims must be considered as whole. In re Schneller, 158 U.S.P.Q. 210, 215 (C.C.P.A. 1968).

It should also be noted that some could assert that the claims of one or more of the cited conflicting applications dominate over the claims of this application. Even though such claims may dominate in some contexts and may be dominated in others, domination is simply not the issue. Domination and double patenting should not be confused. General Foods Corp. v. Studiengesellschaft Kohle mbH, 23 U.S.P.Q. 2d 1839, 1843 (Fed. Cir. 1992) (see column 2, last paragraph or quote on page 1843). Claims of one patent dominating over another does not yield a double patenting rejection. Rather, the claims as a whole must be evaluated to determine if they are patentably distinct. Id. This must be done using prior art and not the applications themselves.

Inquiry is made why Applicants did not present all these claims in one application. An answer is not necessary since each of the applications cited are directed to structurally different devices that are often asserted to be separate species.

#### Claims 1-5 Obvious

Claims 1-5 stand rejected under 35 U.S.C. § 103 as obvious over Dalebout et al. '396 (hereinafter referred to as "Dalebout") in view of Day and Doetsch.

Day teaches construction of a non-motorized treadmill having rollers ostensibly covered or coated with rubber to function as rubber treads 20. (Page 1, Col. 2, lines 92-92). It does not show an endless belt of the type shown in Dalebout. Thus, Dalebout and Day teach different "tread" mechanisms. To make the asserted combination, one must reject the Day rollers and substitute the tread of Dalebout or vice versa. That is, the teachings of one or the other reference must be abandoned to make the asserted combination. Absent a teaching to do so, the substitution is hindsight effected because of Applicants' teachings.

Dalebout has uprights that extend up from the base frame. An inclination system underlies the deck. Thus, to make the combination asserted, one would ostensibly need to abandon the inclination system of Dalebout (which is the focus of the application) or completely reconfigure the Dalebout machine without any clear teaching in the art to do so.

That is, the Dalebout reference would not work if the deck is supported by uprights because the inclination system would no longer be operative. In turn, the combination can be made only by rejecting the central teachings of Dalebout. Such a combination is not proper.

Dalebout also has a motorized tread with its inherent underlying heavy deck. One would need to totally reconfigure Day to accommodate the deck and motor with no teaching as how to do so. Thus, the combination of Dalebout and Day cannot be made and, as asserted, is improper.

Doetsch has nothing to solve the deficiencies of the combination of Dalebout and Day. Doetsch simply teaches construction of a gas cylinder. To select a gas cylinder is to rely on hindsight using applications teachings. That is, there is no teaching associated with, for example, Day, that one should use lift means to assist in raising a tread base from a use or operational configuration to a storage configuration. The broad teaching of Doetsch cannot be said to constitute a teaching that a treadmill base can be made to be attached spaced from its front end to rotate as claimed.

Claim 1 as amended defines a combination structure for rotating the tread base between a use position and a storage position and with lift means to urge the tread toward the second position. The tread base is attached spaced from its front end to rotate. Nothing in Day or Dalebout, separately or together, results in such a treadmill or suggests the desirability of a treadmill with a separate tread base that rotates as defined. Doetsch certainly does not teach construction of such a treadmill. Doetsch may teach utility in a number of situations, but it cannot be said to teach or suggest that treadmills be configured in a particular way or that treadmills be so constructed because such treadmills did not exist.

In view of the above, it is asserted that the rejection of claim 1 as now amended is improper because the combination structure is made with the benefit of hindsight. The asserted combination does not result in, teach or suggest the structure as defined by claim 1. The rejection should be withdrawn.

Claims 2-5 are deemed allowable because they continue to depend from allowable claim 1.

New Claims 10-13

New claim 10 defines a treadmill which has means to stably retain the tread base in the second position or storage position when the tread base is rotated to the second or storage position. Neither Dalebout nor Day suggest structure as now defined by claim 10. Doetsch has nothing to cure the deficiencies of Dalebout and Day. In turn, claim 10 is not obvious and is allowable as presented.

New claim 11 is dependent from claim 10 and, in turn, is allowable for the same reasons that claim 10 is allowable. Claim 10 is also asserted to define novel subject matter because it defines a treadmill having a tread base with a mass and a center of gravity positioned relative to the axis of rotation that is not disclosed or taught by any of the applied references.

Claim 12 includes limitations defining the mass of the treadmill and the center of gravity. The center of gravity is positioned (with the tread base in the second position) to stably support the tread base in the second position. The center of gravity is positioned relative to the axis of rotation so that a lever arm or a torque is developed to hold the tread base in the second or stored position. Thus, the device as claimed is totally different from that of Day, Dalebout and Doetsch, taken separately or together, because the device as claimed does not require anything like the set screws 16 or other suitable structure to hold the device and sustain or retain it over the lever arm or torque that the mass of the tread frame 13 is developing (gravity acting through the center of gravity which is vertically spaced from the vertical over the bar 12) when in the stored configuration.

Turning to FIG. 2 of Day, it can be seen that the tread frame is in its stored configuration or position. By definition, the tread frame 13 is between the handles 27. It cannot be positioned over the support bar 12 because of handles 31 and the cross bar 30. Therefore, the tread frame 13 obviously will fall back down if the user were to let go after raising the tread frame 13 to the position shown in FIG. 2. To preclude further movement, Day teaches one to employ the set screws 16 or any other suitable means for holding the tread frame in its elevated position. To the extent that the tread frame 13 can be said to have mass and, in turn, a center of gravity, as stated hereinbefore, it would presumably be displaced from the vertical above the bar 12 because the tread frame 13 cannot be moved

over the bar 12 due to the interference of the cross bar 30. Thus, a lever arm or a torque is available to urge the tread frame to rotate counterclockwise as can be seen in FIG. 2 of Day. Thus, some kind of mechanical device is necessary to hold the tread frame up or in its storage position.

New claim 13 is claim 1 rewritten with the limitations of claims 1 through 6 with deletions and corrections to eliminate unnecessary words and with clarifications to better state the claim. Although it does not include the identical language of the intervening dependent claims, claim 13 is nonetheless believed to be fully allowable because it is essentially a restatement of claim 6 which was stated to be allowable.

Allowable Claims

At page 6 of the Office Action, it is stated that claims 6-9 would be allowable if rewritten in allowable form. Claim 13 is claim 6 rewritten as stated above. Claim 7 and, in turn, claims 8 and 9, now depend from claim 13 and are in turn regarded as fully allowable.

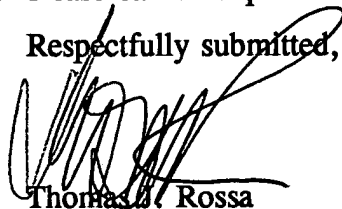
SUMMARY

Claim 1 clearly defines over the art separately presented or as combined. In turn, early action and allowance is requested.

If any additional fees are required in association with this Amendment in addition to those included, they may be charged to Deposit Account 20-1469.

If there are any questions or concerns, inquiry should be directed to the undersigned counsel at (801) 532-1922 so that processing of this case can be expedited.

Respectfully submitted,



Thomas A. Rossa  
Registration No. 26,799  
Attorney for Applicants  
TRASK, BRITT & ROSSA  
P. O. Box 2550  
Salt Lake City, Utah 84110-2550  
Telephone: (801) 532-1922

Date: October 31, 1996  
TJR/jml  
N:\1442\2783\FIRSTAME.AMD 10/31/96